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No. 06-1397

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IN THE

Supreme Court of the United States

PLANET BINGO, LLC AND GARY WEINGARDT,
Petitioners,

v.

GAMETECH INTERNATIONAL, INC., RICHARD FEDOR, GARY HELD AND GRAHAM LEONARD,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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RESPONDENTS' BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

1. Whether the Federal Circuit erred when it found no infringement under the doctrine of equivalents as a matter of law on the grounds that determining the winning combination in bingo "before" the game begins—as dictated by the express language of the patents' claims, the specification, the file history, and the extrinsic evidence—is not equivalent to determining the winning combination "after" the game begins.

2. Whether the issue of infringement under the doctrine of equivalents is always a jury determination and never for the Court, as long as the patentee offers an expert report on the issue of equivalents.

RULE 29.6 STATEMENT

GameTech International, Inc. has no parent corporation, and no publicly held company owns 10 percent or more of its stock.

TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED	i
RULE 29.6 STATEMENT	ii
TABLE OF AUTHORITIES	iv
INTRODUCTION	1
COUNTERSTATEMENT	2
REASONS FOR DENYING THE PETITION	9
I. THE FEDERAL CIRCUIT'S APPLICATION OF THE DOCTRINE OF EQUIVALENTS DOES NOT WARRANT THIS COURT'S REVIEW	9
A. The Federal Circuit's Application of the Doctrine of Equivalents Does Not Conflict with the Decisions of this Court	9
B. There Is No Intra-Circuit Conflict Over the Doctrine of Equivalents	13
C. The Decision Below Correctly Affirmed Summary Judgment of Non-Infringement Under the Doctrine of Equivalents	17
D. This Case Is a Poor Vehicle for Reconsidering the Doctrine of Equivalents	22
II. THE DECISION BELOW DOES NOT ADDRESS THE ROLE OF JURIES IN APPLYING THE DOCTRINE OF EQUIVALENTS	24
CONCLUSION	25

TABLE OF AUTHORITIES

CASES Page

Abbott Laboratories v. Dey, L.P., 287 F.3d 1097 (Fed. Cir. 2002) 14
Adickes v. S.H. Kress & Co., 398 U.S. 144 (1970) 24
Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc., 469 F.3d 1005 (Fed. Cir. 2006) 16
Edwards v. Aguillard, 482 U.S. 578 (1987) 21
Ericsson, Inc. v. Harris Corp., 352 F.3d 1369 (Fed. Cir. 2003) 15
Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp., 149 F.3d 1309 (Fed. Cir. 1998) 15, 16
Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 535 U.S. 722 (2002) 10, 17, 19, 21, 22
Freedman Seating Co. v. Am. Seating Co., 420 F.3d 1350 (Fed. Cir. 2005) 11
Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605 ..... 17, 20
Hilton Davis Chem. Co. v. Warner-Jenkinson, Inc., 114 F.3d 1161 (Fed. Cir. 1997) 12
Joy Technologies, Inc. v. Flakt, Inc., 6 F.3d 770 (Fed. Cir. 1993) 6, 22
KSR Int'l. Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007) 21
LG Electronics, Inc. v. Bizcom Electronics, Inc., 453 F.3d 1364 (Fed. Cir. 2006) 11
Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996) 10
Optical Disc Corp. v. Del Mar Avionics, 208 F.3d 1324 (Fed. Cir. 2000) 13, 14
Ortho-McNeill Pharmaceutical, Inc. v. Caraco Pharmaceutical Laboratories, Ltd., 476 F.3d 1321 (Fed. Cir. 2007) 11, 14

TABLE OF AUTHORITIES—Continued

Page

Primos, Inc. v. Hunter's Specialties, Inc., 451 F.3d 841 (Fed. Cir. 2006) 11

Sage Products, Inc. v. Devon Indus., Inc., 126 F.3d 1420 (Fed. Cir. 1997) 13

Standard Havens Products, Inc. v. Gencor Industries, Inc. 953 F.2d 1360 (Fed. Cir. 1991), *cert. denied* 506 U.S. 817 (1992) 6, 22

TRW Inc. v. Andrews, 534 U.S. 19 (2001)..... 24

Tanabe Seriyaku Co. v. U.S. Int'l Trade Comm'n, 109 F.3d 726 (Fed. Cir. 1997) 18, 19

Tronzo v. Biomet, Inc., 156 F.3d 1154 (Fed. Cir. 1998) 16

Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17 (1997) ..... *passim*

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RESPONDENTS' BRIEF IN OPPOSITION

Respondents GameTech International, Inc., Richard Fedor, Gary Held, and Graham Leonard (collectively, "GameTech") respectfully submit this brief in opposition to the petition for a writ of certiorari in this case.

INTRODUCTION

Petitioners contend that the decision below warrants review because it flouts the decisions of this Court. In fact, the decision below applies a central principle of this Court's teachings on the doctrine of equivalents: "[T]hat the application of the doctrine, even as to an individual element, is

not allowed such broad play as to effectively eliminate that element in its entirety." *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29 (1997). Far from contradicting this principle, the Federal Circuit's application of the doctrine of equivalents in this case faithfully adheres to it. Petitioners' assertion of a conflict within the Federal Circuit over application of the doctrine of equivalents is similarly unfounded. In addition to the legal reasons for denying the petition, factually, this case would make a poor vehicle for reconsidering the doctrine of equivalents because of the unusual nature of the allegations and the record developed below. The Court should deny the petition.

COUNTERSTATEMENT

This case concerns various methods for adding a progressive jackpot element to a conventional bingo game. A conventional bingo game involves bingo cards, bingo balls, a hopper or blower, and a flashboard (the electronic board that tells players which bingo balls have been called in a bingo game). Pet. App. 18a. The players have one or more bingo cards with a matrix of rows and columns. Pet. App. 19a. Usually the columns are labeled B, I, N, G, and O, and numbers are divided among the rows so that each space has a unique letter and number. *Id.* Before the game begins, a winning combination, such as a row, column, diagonal or some other pattern on the player's bingo card, is determined. *Id.* Then, the bingo balls are mixed in the hopper or blower and randomly selected one at a time. *Id.* As numbers on the bingo balls are announced, players mark spaces on their bingo cards corresponding to the selected ball until a player gets the winning combination and announces "Bingo!" *Id.*

Planet Bingo markets a variation on the conventional bingo game called MP Bingo.[1] MP Bingo attempts to introduce a progressive jackpot element by adding colors to the bingo flashboard. J.A. 1616-18. Before the start of each bingo game, MP Bingo determines a winning combination, such as a row, column, diagonal or some other pattern on the player's bingo card, and adds colors to the bingo flashboard. *Id.* Players play bingo in the above described conventional method. *Id.* When a player achieves the predetermined pattern, the amount of the player's jackpot is dictated by the color of the player's bingo. *Id.* Thus, for example, a "red" bingo will have a different jackpot prize than a "yellow" bingo. *Id.* MP Bingo is progressive: If a player does not win a "red" bingo in a particular bingo game, the prize will carry over to the next game. *Id.*

In late 2001, GameTech began developing a concept for its own progressive bingo game, which it called Rainbow Bingo. Pet. App. 20a. In this game concept, the winning combination would not be determined before each bingo game begins, and it would not involve application of colors to the bingo flashboard. *Id.* Instead, after the first ball is drawn, each column in the bingo card would randomly be assigned a color, each row would randomly be assigned a jewel or coin symbol, and one diamond number would be randomly selected in each column. *Id.* Then, prizes would be awarded for bingos in a particular colored column. Other prizes would be awarded based on the presence of a jewel or a coin on a

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[1] Normally, in a patent case, the similarity between the asserted claims and the patentee's own products is irrelevant. GameTech presents this limited discussion of Planet Bingo's product because, as will be shown, Planet Bingos' expert made a variety of methodological errors, including comparing GameTech's Rainbow Bingo concept against Planet Bingo's MP Bingo game, not the '289 or '786 patents. MP Bingo also reflects how Planet Bingo itself "predetermines" (*i.e.*, determines before the game begins) a winning combination.

player's card. Pet. App. 21a. Prizes would progress from game to game until won. *Id.*

GameTech tested the waters for Rainbow Bingo by producing a demo tape, handing out some brochures and talking to potential customers. This game concept was, however, never developed into an actual working product. As a consequence, Rainbow Bingo was never made, used, played, wagered-on, or sold. Pet. App. 20a. Nevertheless, shortly after learning of GameTech's research, Planet Bingo and the inventor of the asserted patents, Gary Weingardt (hereinafter collectively "Planet Bingo"), brought this action, asserting GameTech had infringed U.S. Patent No. 5,482,289 ("'289 patent") and U.S. Patent No. 5,727,786 ("'786 patent"), of which Planet Bingo was a licensee, by "offering for sale" the Rainbow Bingo game concept.

Both of the patents asserted by Planet Bingo are directed to methods of adding a second, progressive jackpot to the conventional bingo game. The '786 patent contains claims disclosing a method of designating spaces on the flashboard with colors or other markings to create the second progressive jackpot. Pet. App. 20a. The '289 patent contains claims disclosing methods of adding "indicia" (colors, patterns or other markings) to the bingo balls to create this second progressive jackpot. Pet. App. 19a-20a.[2]

Each asserted claim in both patents requires that the "winning combination" associated with the bingo balls or flashboard containing these indicia be "predetermined." J.A. 105-07, 122-25. Gary Weingardt, the sole named inventor on the '289 and '786 patents, testified that he understood the

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[2] The '289 patent also contains claims for bingo games with a second progressive jackpot that do not require the application of indicia. Although these claims were asserted below, they were found invalid due to anticipation by prior art. Pet. App. 13a-15a. Planet Bingo has not sought review of this determination here.

term "predetermined winning combination" to mean a winning combination determined before the game begins. J.A. 1701. According to Mr. Weingardt, "[y]ou determine the combination before the game. And when they achieve it, it's after the game." *Id.*

The prosecuting attorney for both patents testified that knowing which particular combination of numbers and colors or other markings a player must achieve to win the progressive jackpot before the bingo game begins was "an important distinguishing feature" of Mr. Weingardt's invention. J.A. 1663. In the prosecution of a related European application, the prosecuting attorney emphasized the importance of this timing: "The essence of Mr. Weingardt's invention is to randomly designate *prior to the start of the bingo game* some of the bingo numbers with a first designated marking and designating the remaining bingo numbers with a second designated marking," and that this was "very much different than" the prior art. J.A. 3362, 3364 (emphasis in original).

The specifications for both patents reflect the understanding of the inventor and the prosecuting attorney. Both repeatedly explain that the winning combination must be determined and disclosed before the first bingo ball is drawn. Pet. App. 8a. For example, the specification for the '289 patent states that the operator of the bingo game "will designate at the beginning of the game which particular combination or combination of spots will be winning combinations for that particular game." *Id.* The specification for the '786 patent contains a nearly identical statement, *id.*, and it goes on to observe that "[p]rior to each game, some of the numbers on the display board are specifically designated" with distinctive markings and that "[e]ach player can then see at the beginning of a game which of the bingo numbers have the various distinctions." Pet. App. 8a-9a.

Prior to claim construction, the parties each moved for summary judgment on non-infringement and invalidity. The

district court denied both parties' motions and ordered a *Markman* hearing. This hearing was conducted before a magistrate judge, who found that a "predetermined winning combination" means that "the precise elements necessary to achieve a 'bingo' in a particular game [be] determined *before* the first bingo ball is drawn." J.A. 13, 16 (emphasis added). Over Planet Bingo's objections, the district court adopted the magistrate judge's construction. J.A. 17-18.

In light of this claim construction, GameTech filed several case dispositive motions *in limine*, including a motion to exclude all evidence of infringement based on the claim construction.[3] The district court granted GameTech's motion on April 18, 2005.

The district court held that the Rainbow Bingo game concept did not literally infringe the asserted '289 patent claims because "[i]t is undisputed that Rainbow Bingo would not physically mark the bingo balls." Pet. App., 27a. The district court also found that the Rainbow Bingo game concept could not literally infringe the asserted claims in either the '289 or '786 patents because in the Rainbow Bingo game concept, the winning combination is not determined

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[3] GameTech also moved for summary judgment on alternative grounds, including (a) there was no evidence that Rainbow Bingo had ever been "offered for sale" by GameTech—and, in particular, no evidence that GameTech had communicated to any potential customer any price associated with any version of Rainbow Bingo—and therefore no basis to claim infringement, and (b) because the claims at issue in this case are purely "method" claims, and because method claims can only be infringed by practicing the methods, not by "offering for sale" an apparatus—much less the concept of such an apparatus—that allegedly practices the methods, GameTech could not, as a matter of law, have infringed any of the claims of the '289 or '786 patents. *See Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 953 F.2d 1360, 1374 (Fed. Cir. 1991), *cert. denied* 506 U.S. 817 (1992); *Joy Technologies, Inc. v. Flakt, Inc.*, 6 F.3d 770, 775 (Fed. Cir. 1993). Neither the district court nor the court of appeals reached these arguments.

until after the game begins and therefore does not include a "predetermined winning combination" as required by the asserted claims. Pet. App., 29a-30a.

In opposition to GameTech's motion, Planet Bingo submitted a report from its expert, Susan Barrick. With respect to infringement under the doctrine of equivalents, Ms. Barrick stated that she did "not believe there is a 'bingo' reason to wait until one ball is called before making color, jewel, and diamond assignments." J.A. 818. Ms. Barrick further stated conclusorily that she believed the approaches in the asserted claims and the Rainbow Bingo game concept "are substantially the same, that they accomplish substantially the same result and that they do so in substantially the same manner." J.A. 820. In response to a separate motion filed by GameTech, the district court excluded Ms. Barrick from testifying on the issue of infringement on the grounds that she did not have sufficient expertise and had improperly compared the Rainbow Bingo game concept to Planet Bingo's MP Bingo game instead of the asserted patent claims. J.A. 77.

The district court also rejected Planet Bingo's claim of infringement under the doctrine of equivalents. While "slight" in an abstract/temporal sense, the district court found the difference in when the winning combination is determined substantial in the context of the patents asserted by Planet Bingo, because those patents require determination of the winning combination before the game begins. Pet. App. 34a. As the district court observed: "'After' is the very antithesis of 'before,' and cannot be its equivalent as a matter of law." *Id.* The district court also recognized: "[Mr.] Weingardt could have phrased his claims to include a game method where the winning combination is determined before and after the first ball is drawn if he wanted broader protection for his game method." Pet. App. 36a.

The Federal Circuit affirmed the district court. It held that there was no literal infringement because, among other

things, the asserted claims require determination of the combination needed to win the progressive jackpot before the bingo game begins, not afterwards as in the Rainbow Bingo game concept.[4] Pet. App. 5a-10a. Although Planet Bingo acknowledged that the asserted claims require the winning combination to be fixed before the bingo game begins, it argued that it was enough if the participants know the rules beforehand. Pet. App. 7a. The Federal Circuit rejected this argument because the patent claims require a "predetermined winning combination, not a pre-determined rule." *Id.* The Federal Circuit found this conclusion clearly confirmed by the patent specifications which "repeatedly . . . explain[] that the game determines the 'winning combination' before the first bingo ball is drawn." Pet. App. 8a.

The Federal Circuit also held that there was no infringement under the doctrine of equivalents, rejecting Planet Bingo's argument that determining the winning combination right after the game begins rather than before is an "insubstantial variation." Pet. App. 10a. The Federal Circuit recognized that under this Court's discussion in *Warner-Jenkinson* the doctrine of equivalents cannot be used to eliminate a claim element entirely. Pet. App. 11a. Because the requirement of a "pre-determined winning combination" is a "distinct limitation, which was part of the bargain when the patent was issued," the Federal Circuit concluded that it could not overlook the limitation or apply the doctrine of equivalents beyond its purpose so as "to allow recapture of subject matter excluded by a deliberate and foreseeable claim drafting decision." *Id.* Accordingly, the Federal Circuit rejected Planet Bingo's doctrine of equivalents claim as a matter of law. Pet. App. 11a-13a.

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[4] Planet Bingo has not contested the district court's determination that there was no literal infringement of the '289 because the Rainbow Bingo concept never contemplated marking bingo balls.

The Federal Circuit denied Planet Bingo's subsequent petition for rehearing without dissent or request for response. Pet. App. 38a.

REASONS FOR DENYING THE PETITION

I. THE FEDERAL CIRCUIT'S APPLICATION OF THE DOCTRINE OF EQUIVALENTS DOES NOT WARRANT THIS COURT'S REVIEW.

Petitioners contend that the Federal Circuit has developed "a 'vitiation doctrine' and a confusing and irreconcilable jurisprudence." Pet. 14. According to petitioners, this "vitiation doctrine" takes a "rigid, linguistic approach in which the judge determines whether a claim term in the element for which equivalents is alleged has an antonym, or is otherwise particularly specific." *Id.* In fact, the Federal Circuit has not applied a rigid, linguistic test to the doctrine of equivalents analysis, much less created an irreconcilable jurisprudence. To the contrary, it has faithfully applied the principles announced by this Court to the specific facts of the cases before it. Moreover, it properly applied the doctrine of equivalents to this case. Certiorari should be denied.

A. The Federal Circuit's Application of the Doctrine of Equivalents Does Not Conflict with the Decisions of this Court.

According to petitioners' alarmist characterization, the Federal Circuit has "seiz[ed] on a single word in a footnote" in this Court's opinion in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), Pet. 2, and constructed out of that footnote a "vitiation" doctrine, Pet. 3, which applies a "rigid, linguistic approach" that subverts the doctrine of equivalents by making its application turn upon the "happenstance of word choice." Pet. 14, 26. This is simply not true. As the decision below demonstrates, the Federal Circuit has been faithfully applying the principles announced by this Court in *Warner-Jenkinson*.

The principle that the doctrine of equivalents cannot be used to vitiate any element of a claim is not some minor exception that has been hijacked to swallow the doctrine of equivalents. It is a core component of the doctrine. In *Warner-Jenkinson*, this Court considered whether the doctrine of equivalents can be reconciled with the fundamental axiom that the scope of a patent is defined by its claim language. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996) (noting that the claim is "the portion of the patent document that defines the scope of the patentee's rights"). The Court concluded that the doctrine is consistent with the definitional function of claim language if each element of a patent claim is deemed material, and the doctrine of equivalents is applied only to "individual elements of the claim, not to the invention as a whole." *Warner-Jenkinson*, 520 U.S. at 29. In this way, the doctrine of equivalents ensures that the elements of a patent claim reach matters not literally covered by the wording of a particular claim due to the inherent infirmities of language, without expanding the intended scope of those elements. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 734 (2002) ("The doctrine of equivalents is premised on language's inability to capture the essence of innovation."). *Warner-Jenkinson* stressed, however, that, even under the doctrine of equivalents, the scope of a patent is defined by the claim language. The Court therefore cautioned that in applying the doctrine of equivalents, courts must exercise "special vigilance against allowing the concept of equivalence to eliminate completely any [individual] elements." *Warner-Jenkinson*, 520 U.S. at 40; *see also id.* at 29 ("It is important to ensure that the application of the doctrine . . . is not allowed such broad play as to effectively eliminate the element in its entirety.").

The Federal Circuit faithfully adheres to the principle that, even under the doctrine of equivalents, the scope of a patent is defined by its claim language. Applying *Warner-Jenkinson*,

the Federal Circuit has recognized an "all elements" or "all limitations" rule. This rule requires that "equivalence be assessed on a limitation-by-limitation basis" and that no finding of equivalence can be made "if such a finding would entirely vitiate the limitation" in question. *Freedman Seating Co. v. Am. Seating Co.*, 420 F.3d 1350, 1358 (Fed. Cir. 2005). Contrary to Planet Bingo's assertions, this all limitations rule is not applied in a rigid fashion that focuses blindly on word choice. Instead, it is a flexible, context-specific test:

> There is no set formula for determining whether a finding of equivalence would vitiate a claim limitation, and therefore violate the all limitations rule. Rather, courts must consider the totality of circumstances of each case and determine whether the alleged equivalent can be fairly characterized as an insubstantial change from the claimed subject matter without rendering the pertinent limitation meaningless.

Id. at 1359; *accord LG Electronics, Inc. v. Bizcom Electronics, Inc.*, 453 F.3d 1364, 1380 (Fed. Cir. 2006); *Primos, Inc. v. Hunter's Specialties, Inc.*, 451 F.3d 841, 850 (Fed. Cir. 2006).

Contrary to Planet Bingo's argument, the Federal Circuit's decision in *Ortho-McNeil Pharmaceutical, Inc. v. Caraco Pharmaceutical Laboratories, Ltd.*, 476 F.3d 1321 (Fed. Cir. 2007), does not suggest otherwise. Planet Bingo asserts that, by finding no genuine issue concerning application of the doctrine of equivalents to a patent for a chemical composition, *Ortho-McNeil* directly conflicts with *Warner-Jenkinson*, which according to Planet Bingo, found a genuine issue concerning application of the doctrine of equivalents to a chemical composition patent. Pet. 17. In fact, although the plaintiff in *Warner-Jenkinson* sought to apply the doctrine of equivalents to a chemical composition patent, this Court did not consider whether there was a genuine issue. Instead, it remanded that issue to the Federal Circuit, *see Warner-*

Jenkinson, 520 U.S. at 41, which found the doctrine applicable "in the context of the claimed process," *Hilton Davis Chem. Co. v. Warner-Jenkinson Co., Inc.*, 114 F.3d 1161, 1164 (Fed. Cir. 1997).

The decision below does not support Planet Bingo either. The Federal Circuit did not, as Planet Bingo asserts, refuse to apply the doctrine of equivalents based upon a rigid formula. Rather, it recognized that Planet Bingo's patent claims contain a "distinct limitation"—a winning combination that is "predetermined," that is, determined before the bingo game begins—which was included by a "deliberate and foreseeable claim drafting decision." Pet. App. 11a-12a. Planet Bingo failed, however, to explain how this limitation could be applied to winning combinations determined after the game begins without allowing Planet Bingo to capture subject matter deliberately excluded by the claim language. Accordingly, the Federal Circuit found no infringement under the doctrine of equivalents. *Id.* Far from flouting *Warner-Jenkinson*, the conclusion is a logical corollary to this Court's recognition that the doctrine of equivalents reaches matters inadvertently not covered due to the infirmities of a claim's language, not matters deliberately excluded by that language.

Planet Bingo also contends that the Federal Circuit has ignored this Court's "consistent emphasis on the concept of 'insubstantial' differences." Pet. 12 (emphasis and capitalization omitted). Quite the contrary, *Warner-Jenkinson* considered the so-called insubstantial differences test, and it noted that the test offers little guidance "as to what might render a given difference 'insubstantial.'" 520 U.S. at 39-40. More important, this Court stated that the particular formulation of the test was less significant than whether the test performs the "essential inquiry: Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?" *Id.* at 40. Planet Bingo does not—and cannot—dispute that in the decision below and

other cases Planet Bingo cites, the Federal Circuit has adhered to this inquiry.

B. There Is No Intra-Circuit Conflict over the Doctrine of Equivalents.

Planet Bingo argues that the differing outcomes in Federal Circuit doctrine of equivalents decisions reflect a conflict within the Federal Circuit over the rigid "linguistic" test formulated by the Circuit. Pet. 17-20. There is no such test and therefore no conflict over it. Rather, the supposed disarray in the Federal Circuit reported by Planet Bingo reflects the highly context-specific nature of the analysis employed, which yields differing outcomes based upon differences in claim language, specifications, prosecution histories, and other evidence.

For example, citing two cases, Planet Bingo claims that a conflict exists within the Federal Circuit over how to deal with "narrowing structural language." One case cited by Planet Bingo, *Sage Products, Inc. v. Devon Indus., Inc.*, 126 F.3d 1420 (Fed. Cir. 1997), concerned a patent for a container with a particular structure for disposing of medical waste. *Id.* at 1422. The plaintiff contended that a container that did not place the slot for inserting waste at the top as directed by the asserted claim nonetheless infringed under the doctrine of equivalents. Finding that the location of the slot was essential to the claim limitation, the Federal Circuit found no infringement under the doctrine of equivalents. *See id.* at 1424-25. The other case cited by Planet Bingo, *Optical Disc Corp. v. Del Mar Avionics*, 208 F.3d 1324 (Fed. Cir. 2000), concerned a patent for a method of writing music onto CDs with lasers using a waveform with "ramped trailing edges" that produces a certain thermal profile of the "pit" in the CDs carved by the lasers. *Id.* at 1331. The allegedly infringing product used a slightly different shape for the trailing edge of the laser, "a double-step" rather than a ramp, which created the same thermal profile. *Id.* at 1335-36. Finding that the precise

shape of the waveform was not essential to the claim limitation in question, the Federal Circuit remanded for consideration of the doctrine of equivalents. *Id.* Thus, the Federal Circuit reached different conclusions about the doctrine of equivalents arguments in *Sage* and *Optical Disc* because the cases involved different types of "structural" claim limitations with different significance in the different asserted patent claims.

The supposed conflict in the Federal Circuit's treatment of chemical ranges (Pet. 19) similarly reflects differences in particular claim limitations and prosecution histories. One of the two cases cited by Planet Bingo, *Abbott Laboratories v. Dey, L.P.*, 287 F.3d 1097 (Fed. Cir. 2002), involved a patent for a composition containing seven ingredients. *See id.* at 1100. In the allegedly infringing product, the composition of one of these ingredients was from 1%-4% greater than the range specified in the patent, *see id.* at 1100 (patent specified range of 68.6-90.7% for phospholipds); *id.* at 1101 (allegedly infringing product was 91.8%- 94.5% phospholipid), and the Federal Circuit found infringement under the doctrine of equivalents. *See id.* at 1107-08. The other case, *Ortho-McNeil Pharm., Inc. v. Caraco Pharm. Labs., Inc.*, 476 F.3d 1321, involved a patent for a composition of two drugs alleged to have "superadditive or synergistic" effects at a ratio of "about 1:5." *Id.* at 1323-24. The allegedly infringing product had a ratio of 1:7.5, which is 50% higher than the ratio specified in the patent and outside the confidence intervals demonstrating statistical significance. *See id.* at 1328; *see also id.* (finding that any ratio above 1:7.1 is statistically different from a ratio of 1:5). Because the patent pointed to confidence levels, and because the patentee withdrew broader claims that it admitted were invalid, the Federal Circuit found no infringement under the doctrine of equivalents. *See id.* at 1328-29. Thus, in *Ortho-McNeil* where the Federal Circuit found no infringement under the doctrine of equivalents, there was a much greater difference in composition than in *Abbott Labs*, where

it found such infringement, and the prosecution history established that the p[illegible]e ratio was deliberately chosen by the patentee to ensure validity.

The timing cases cited by Planet Bingo (Pet. 18-19) also reflect dispositive differences in fact. One of these cases, *Ericsson, Inc. v. Harris Corp.*, 352 F.3d 1369 (Fed. Cir. 2003), concerned a patent directed to an apparatus for supplying power to a telephone set in a telecommunications system. *Id.* at 1371. The infringement determination turned on a claim limitation that required that speech amplifiers *only* supply power to the telephone set in the off-hook position. The accused apparatus had control circuitry that supplied power to the telephone set less than 0.1% of the time in the on-hook position. The Federal Circuit reversed the district court's finding of no infringement on the grounds that (a) the accused device supplied power from the control circuitry, not from the speech amplifier, as required in the claim and (b) despite the less than 0.1% of time when power might be supplied in the on-hook position, the accused device was "very close" to only supplying power to the telephone set in the off-hook position. *Id.* at 1375. The Federal Circuit reasoned that, while a device that *always* supplied power to the telephone set in the on-hook position would vitiate the claim limitation, a device that did so just 0.1% of the time would not. *Id.* at 1374-75.

The other "timing" case cited by Planet Bingo, *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309 (Fed. Cir. 1998), further demonstrates the Federal Circuit's context-specific approach to application of the doctrine of equivalents. The patent in *Ethicon* was directed to a lockout device for linear cutter staples used in surgery. *Id.* The accused stapler had a lockout bar that was located at one end of the stapler and was held in the path of the pusher assembly until just before the first staple was fired. *Id.* at 1313. The Federal Circuit found no infringement of one claim under the doctrine of equivalents because the claim language spe-

cifically required that the lockout bar be located near the longitudinal slots, and the accused stapler's lockout bar was located "nowhere near the longitudinal slots." *Id.* at 1318. Because the lockout bar in the accused stapler was "not even close"—in fact, in the "opposite" direction—to the claimed location, the Federal Circuit found the district court correctly found no infringement under the doctrine of equivalents and granted summary judgment on that claim. *Id.* at 1319. The Federal Circuit reversed summary judgment on another claim, which required a restraining structure which contacts the barrier "during staple firing." *Id.* at 1320. The evidence showed that the accused stapler lost contact with the barrier for a few thousandths of a second just before staple firing. Finding this to be "a subtle difference in degree, not a clear, substantial difference or difference in kind," the Federal Circuit found a genuine issue concerning infringement under the doctrine of equivalents. *Id.* at 1321. Thus, it was the particular claim language that dictated the result in these "timing" cases.

The final pair of cases cited by Planet Bingo, *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005 (Fed. Cir. 2006), and *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998), are similarly reconcilable. Both of these cases dealt with claim limitations relating to shapes, but there was a crucial difference in the prosecution history for the claims in these cases. In *Tronzo*, claims for a device with no specific shape were held invalid for lack of adequate disclosure in the description, *see* 156 F.3d at 1158-60, and the Federal Circuit concluded that the patentee therefore could not use the doctrine of equivalents to argue that any shape was the equivalent of the conical shape specified in the patent. *See id.* at 1160. There was no similar prosecution history in *Depuy Spine*. Thus, the different rulings in *Depuy Spine* and *Tronzo* reflect differences in the prosecution histories of the patents, not the inconsistent application of any rigid test.

As this discussion makes clear, all of the decisions cited by Planet Bingo as reflecting inconsistency in the application of the doctrine of equivalents are readily explained and reconciled by the highly context-specific nature of the analysis employed in each case. Ultimately, whether the doctrine of equivalents is applicable in some cases and not in others is dictated by case-specific aspects of the relevant claim language, specifications, prosecution histories, and other case specific evidence.

There is no merit to Planet Bingo's complaint that "[t]here is currently no reliable basis for ascertaining whether a particular claim term will support application of the Federal Circuit's 'vitiation doctrine.'" Pet. 18. This Court's decisions concerning the doctrine of equivalents mandate the application of flexible standards that turn upon the particular facts of the case, and such standards are inevitably difficult to predict, particularly when they are viewed from levels as abstract as timing, chemical composition, and structural limitations. This Court has therefore long recognized that the doctrine of equivalents necessarily creates uncertainty. *See, e.g., Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609 ("In determining equivalents, things equal to the same thing may not be equal to each other and, by the same token, things for most purposes different may sometimes equivalents."). That uncertainty is, however, the "price of ensuring the appropriate incentives for innovation." *Festo*, 535 U.S. at 732. Accordingly, the fact that Planet Bingo is able to identify seeming inconsistencies in the Federal Circuit's application of the doctrine of equivalents provides no reason for reviewing this case.

C. The Decision Below Correctly Affirmed Summary Judgment of Non-Infringement Under the Doctrine of Equivalents.

Planet Bingo sued GameTech and various officers for infringing patents that, by their unambiguous terms, as con-

firmed by the claim language, patent specifications, and the admissions of the inventor and his prosecuting attorney, require that the "winning combination" for any bingo game be "*pre*determined." All parties recognized before the district court that this term means determined "before" the start of the bingo game (though they differed on what exactly needed to be determined, *see supra* p. 8). Because GameTech's accused bingo game "concept" required the winning combination to be determined *after* the beginning of the bingo game, and because the inventor deliberately chose to limit the language of his claims to winning combinations determined before the bingo game begins, the lower courts properly found that there could be no infringement of Planet Bingo's two patents, either literally or under the doctrine of equivalents.

Although Planet Bingo suggests that the claim construction in this case was ill-considered, Pet. 9, it is indisputable that the patent claims at issue in this case are limited to bingo games in which the winning combination for a progressive jackpot is determined before the game begins. Each asserted claim in both patents claims a "predetermined" winning combination, which in context clearly indicates a determination prior to the beginning of the bingo game. Pet. App. 19a-20a. Any possible doubt about this meaning of the claim language is dispelled by the specifications, prosecution history material, and the admissions of the inventor and his prosecuting counsel.

The specifications state that that the operator of the game "will designate at the beginning of the game which particular combination or combinations will be winning combinations for that particular game" and that "[p]rior to each game," numbers on the display board will be specifically designated" so that "[e]ach player can then see at the beginning of the game" the designations. Pet. App. 8a-9a. Moreover, the inventor admitted that the term "predetermined winning com-

bination" refers to a winning combination decided and disclosed before the game started. J.A. 1701; *see also Tanabe Seriyaku Co. v. U.S. Int'l Trade Comm'n*, 109 F.3d 726, 733 (Fed. Cir. 1997) (recognizing the relevance of inventor admissions). Thus, the "predetermined winning combination" limitation was clearly intended to require that the winning combination be determined before the bingo game begins.

The inclusion of this timing requirement was deliberate. As the district court observed, the inventor "could have phrased his claims to include a game method where the winning combination is determined before and after the first ball is drawn if he wanted broader protection for his game method." Pet. App. 36a. Instead, he chose to require a *pre*determined winning combination, which, as the specifications and his own admissions make clear, was intended to require that the winning combination be determined before the game begins. Moreover, as the inventor's prosecuting attorney admitted, this timing limitation was "an important distinguishing feature" of the alleged inventions which was included to distinguish prior art cited in a related European application. J.A. 1663; *see also Tanabe*, 109 F.3d at 733 (recognizing the relevance of representations in prosecuting foreign counterparts). Thus, there is nothing inadvertent or unexpected about the requirement that the winning combination be determined before the bingo game begins.

As the Federal Circuit recognized, such a deliberate claim drafting decision renders the doctrine of equivalents inapplicable. The doctrine is "premised on language's inability to capture the essence of innovation," *Festo*, 535 U.S. at 733, and it therefore "allows the patentee to claim those insubstantial alterations that were not captured in drafting the original patent." *Id.* at 734. It is well-settled, however, that the doctrine of equivalents cannot be used to effectively eliminate any individual elements of a claim and therefore does not allow patentees to capture or recapture subject matter that

they chose to exclude by including particular limitations in their claims. *See Warner-Jenkinson*, 520 U.S. at 30-31. Instead, this Court has held that where "a theory of equivalence would entirely vitiate a particular claim element, partial or complete judgment should be rendered by the court, as there would be no further material issue for the jury to resolve." *Id.* at 39 n.8. That is the case here.

Planet Bingo contends that waiting for one ball to be called before assigning indicia to the bingo card in Rainbow Bingo is a "gimmick," and that the difference between the timing of determining a winning combination in Rainbow Bingo and in the asserted claims was slight and therefore insubstantial. Pet. 8, 25-26. The deliberately included limitations in the asserted claims cannot, however, be ignored. As this Court has repeatedly recognized, "[e]quivalence . . . is not an absolute to be considered in a vacuum." *Warner-Jenkinson*, 520 U.S. at 24-25 (quoting *Graver Tank*, 339 U.S. at 609). Instead, "[w]hat constitutes equivalency must be determined *against the context of the patent*," and "[c]onsideration must be given to the purpose for which an ingredient is used in a patent." *Id.* (emphasis added and quotation omitted). Notably absent from the petition is any attempt to show that the difference between determining the winning combination before the game begins and after the game begins is insubstantial in the context of the patent.

Planet Bingo's "bingo expert" does not save it either. The expert offered no opinion on why the timing difference was insubstantial in the context of the "predetermined winning combination" limitation. Instead, the expert stated that she did "not believe that there is a *'bingo* reason' to wait until one ball is called before making certain color, jewel, and diamond assignments." J.A. 818 (emphasis added). Even if that were true—which it is not (*see* J.A. 1903, 2062, 2064-2065 (the delay was a difference designed to increase the excitement of the game))—it would be still be immaterial because it ignores

the undisputed evidence that the timing requirement was included in the asserted claims deliberately.

Nor does it make any difference that the expert opined that the Rainbow Bingo game concept and the asserted claims are "substantially the same." As this Court has repeatedly recognized, an expert's conclusory opinion cannot create a genuine issue of fact to defeat summary judgment. *See, e.g., KSR Int'l. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1745 (2007); *Edwards v. Aguillard*, 482 U.S. 578, 595 (1987). It is not and should not be the law that summary judgment is defeated in every patent case in which an expert can be found to testify that there was infringement.

Planet Bingo protests that the decision below impermissibly expands the all elements rule by placing dispositive emphasis on a word ("before") that does not appear in the claim limitation and therefore punishes the patentee for a claim drafting decision that the inventor did not make. Pet. 20-21. Planet Bingo cannot ignore, however, that the claim limitation refers to a *pre*determined winning combination. Undisputedly, "pre" means "before." Moreover, as the lower courts found and as described above, the claim language and specifications plainly contemplate establishing the winning combination for each bingo game before each game begins, *see supra* pp. 5, 18 and the admissions of the inventor and his prosecuting attorney confirm that this timing limitation was deliberately included in the patent claims. *See supra* pp. 4-5, 19.

Finally, Planet Bingo contends that the decision below improperly seeks to extend prosecution history estoppel. According to Planet Bingo, this Court held in *Festo* that prosecution history estoppel is the only vehicle for barring application of the doctrine of equivalents based upon the particular words used in the claim. Pet. 22-23. *Festo* suggests nothing of the sort. To the contrary, as pointed out above, *see supra* p. 19, in *Festo*, this Court recognized that

the doctrine of equivalents is premised on "language's inability to capture the essence of innovation." 535 U.S. at 734; *see also id.* at 731 ("Unfortunately, the nature of language makes it impossible to capture the essence of a thing in a patent application."). Moreover, even in that situation, *Festo* did not say that the doctrine of equivalents authorizes courts to ignore language of the patent claims. Instead, it said that the scope of the patent must be understood to include not only its "literal terms" but also "equivalents" to those terms. *Id.* at 732. There is no question about the ability of language to capture the essence of the bingo game described in the asserted patent claims, nor any ambiguity about whether the limitation in question was intended to restrict the patent to winning combinations determined before the bingo game begins. Thus, far from supporting Planet Bingo's argument, *Festo* confirms that the decision below correctly affirmed no infringement under the doctrine of equivalents.

D. This Case Is a Poor Vehicle for Reconsidering the Doctrine of Equivalents.

This case is a poor vehicle for examining the doctrine of equivalents. *First*, there are independent, alternative grounds for affirming the decision below that the Federal Circuit did not reach. For example, because Rainbow Bingo has never been made, used, played, wagered-with, or sold, petitioners' claim of infringement against GameTech alleged only that Rainbow Bingo was "offered for sale." As GameTech pointed out in the courts below, there is no evidence that Rainbow Bingo has been "offered for sale." Although the lower courts did not address this issue, it is a more than adequate alternative ground for finding non-infringement.

In addition, the patent claims at issue here are purely "method" claims, which can only be infringed by practicing the methods. *See Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 953 F.2d 1360, 1374 (Fed. Cir. 1991), *cert. denied* 506 U.S. 817 (1992); *Joy Technologies, Inc. v. Flakt,*

Inc., 6 F.3d 770, 775 (Fed. Cir. 1993). It is undisputed that no one has ever played (or otherwise used) Rainbow Bingo—it is still just a game concept that has never been completed. This is also an alternative ground for non-infringement.

Second, as just noted, there is no ambiguity about the intended scope of the patent claims here: The plain language of the claims, the specifications and the admissions of the inventor and his prosecuting attorney all confirm that the asserted claims were deliberately limited to bingo games in which the winning combination is determined before the game begins. Thus, if it is ever inappropriate to apply the doctrine of equivalents to expand the scope of a claim term, it is inappropriate here.

Third, this case presents the barest and most uninformative context possible. The allegedly infringing product in this case, GameTech's Rainbow Bingo game concept, exists only on paper. As a consequence, no one knows whether actual determination of the "winning combination" in Rainbow Bingo would take place 1 second or 5 second or 30 seconds after the game begins. This case therefore lacks any concrete detail that might inform application of the doctrine of equivalents to here.

This Court should not reassess an aspect of patent law as fundamental as the doctrine of equivalents in such an unusual context. As Planet Bingo acknowledges, Pet. 16-18, the Federal Circuit periodically issues decisions concerning the doctrine of equivalents, and the losing party frequently petitions this Court for review. Accordingly, if the Court sees any need to review the Federal Circuit's application of the doctrine of equivalents, it should easily be able to find a better case in which to do so. Moreover, the Court may benefit from further development and refinement of the issues. Because there is no conflict within the Federal Circuit, this Court does not have the benefit of lower court opinions and dissents sharpening the issues. For these rea-

sons as well, Planet Bingo's request for certiorari on the first question in the petition should be denied.

II. THE DECISION BELOW DOES NOT ADDRESS THE ROLE OF JURIES IN APPLYING THE DOCTRINE OF EQUIVALENTS

The Court also should deny certiorari on the second question presented by the petition. Planet Bingo contends that this case raises a question that *Warner-Jenkinson* left unanswered: whether juries should apply the doctrine of equivalents. Pet. i, 27-29.[5] That is incorrect. Planet Bingo itself filed a motion for summary judgment on infringement, including infringement under the doctrine of equivalents. Thus, before losing on the issue, Planet Bingo believed that the facts of this case were amenable to resolution by the judge rather than a jury. Also, as petitioners recognize, *see* Pet. 9 & n.5, the district court entered summary judgment, which by definition it could only have done if there were no genuine issue for a fact finder to decide. Finally, Planet Bingo waived the jury trial issue by failing to raise it until its petition for rehearing before the Federal Circuit. This issue has not been addressed by the lower courts and is therefore not properly before the Court in this petition. *See, e.g.*, *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 148 n.2 (1970); *TRW Inc. v. Andrews*, 534 U.S. 19, 34 (2001).

In any event, Planet Bingo's contention that its doctrine of equivalents claim should have been presented to a jury is baseless. If under the facts of this case—where the plain language of the claim, the specifications, and the admissions of the inventor and his prosecuting attorney all show a deliberate and unambiguous decision to claim the determination of a winning combination before the bingo game begins, and

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[5] Planet Bingo also suggests that equitable considerations should apply to the doctrine of equivalents analysis. Pet. 29. This Court has already rejected that suggestion. *See Warner-Jenkinson*, 520 U.S. at 36.

where the patentee failed to explain how the doctrine of equivalents can be applied to a determination after the game begins without effectively eliminating the deliberate decision to so limit that claim—the plaintiff's claim must be submitted to a jury, then as a practical matter every case involving the doctrine of equivalents must go to a jury.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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